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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,144	03/24/2004	Vincent Mascio	601194-2US	5278
570	7590	01/05/2006	EXAMINER	
AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103			LAYNO, BENJAMIN	
		ART UNIT	PAPER NUMBER	
		3711		

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Sp

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/808,144	MASCIO, VINCENT	
	<b>Examiner</b>	<b>Art Unit</b>	
	Benjamin H. Layno	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 17 October 2005.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 19 is/are allowed.
- 6) Claim(s) 1-18 and 20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

1. Applicant's arguments with respect to claims 1-18 and 20 have been considered but are moot in view of the new ground(s) of rejection. The 112 rejection has been withdrawn

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Lofink et al.

The patent to Lofink et al. discloses the well known Blackjack game, Spanish 21. Lofink (Spanish 21) comprises all the **physical elements or structure** recited in **apparatus** claims 1-10, including comprising one or more conventional decks of cards, each having a plurality of individual playing cards, each of the individual playing cards having a back, a face, a face suit including one of Hearts, Diamonds, Clubs and Spades, and an associated face value including one of two, three, four, five, six, seven, eight, nine, ten, Jack, Queen, King and Ace, col. 4, line 62 to col. 5, line 6. Lofink further includes the steps of removing all cards having face value of ten from one or more conventional decks of cards (see abstract).

In regard to the claimed “(b) a set of rules for the card game, the rules including:.....” in claims 1, paragraphs (b)(i) – (v), all of claims 2-7, 10, claim 8, paragraphs (b) (i)-(ix) and claim 9, paragraphs (b) (i) – (xvii), these statements are considered game rules. In game **apparatus** claims, only the claimed elements having **physical structure**, (e.g. one or more conventional decks of cards, each having a plurality of individual playing cards, each of the individual playing cards having a back, a face, a face suit including one of Hearts, Diamonds, Clubs.....) are given patentable weight. Game rules, (e.g. “dealing one card to each player face-up and one card to each player face-down”, “paying each player having blackjack two times the respective player’s wager, if the dealer does not have blackjack, blackjack being a condition when two cards add up to twenty-one”, “discarding all of the player’s cards in the players’ first hand and all of the dealer’s cards in the dealer’s first hand except the first card dealt to the dealer”, etc.), however, have **no physical structure per se**. **Thus, game rules have no limiting affect in game apparatus claims.**

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lofink et al. as applied to claim 1 above, and further in view of Zahedi.

The patent to Lofink et al., recited above, discloses many of the steps recited in **method** claims 11-18 and 20, including the steps of permitting each player to surrender after receiving two cards in exchange for one-half of the respective player's wager, col. 4, lines 6-9, requiring the dealer to take another card when the dealer has a combination of cards forming soft seventeen, col. 4, lines 1-2, and requiring the dealer to stand when the dealer has a combination of cards forming soft seventeen, col. 4, lines 4-5. Lofink et al. also discloses the step that a player may place a second wager (Double Down wager) that is separate from the first wager, col. 3, lines 40-47.

The only step recited in claims 11-18 and 20 that Lofink lacks is "paying each player having blackjack two times (two-to-one) the respective player's wager". The patent to Zahedi discloses that it is known in the blackjack art to pay a player having blackjack at two times (two-to-one) the respective player's wager regardless of the value of the dealer's hand, page 2, paragraph [0029]. In view of such teaching, it would have been obvious to modify Lofink's blackjack game by requiring that players having blackjack be paid two times the respective player's wager regardless of the value of the dealer's hand. This modification would have given players the perception of having a better chance at beating the house. Thus, making Lofink's game more exciting to play.

#### ***Allowable Subject Matter***

6. Claim 19 is allowed.
7. The following is a statement of reasons for the indication of allowable subject matter: None of the cited references alone or in combination teach the steps in claim 19

of "discarding all of the player's cards **in the player's first hand**, and all of the dealer's cards in the dealer's first hand, except the first card dealt to the dealer, dealing one card to each player face-up, dealing another card face-up **to form a second player's hand**", the dealer collecting the second wager of each player having a **second hand** total face value of cards less than the dealer's **second hand** total face value of cards.....the dealer paying out one times the second wager of each player having a **second hand** total face value of cards greater than the dealer's **second hand** total face value...." The bold print indicates insertions by the Examiner that would make the claims more definite. Similar insertions should be made throughout claims 8, 9, 18 and 19 in order to make the claims more definite.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (571) 272-4424. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571)272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Benjamin H. Layno  
Primary Examiner  
Art Unit 3711

bhl